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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,876	09/29/2003	Shazia Sadiq	13909-115001 / 2003P00187	7312
32864 7590 07/03/2008 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SAINDON, WILLIAM V	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 07/03/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/671,876	Applicant(s) SADIQ ET AL.	
	Examiner William V. Saindon	Art Unit 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-26 and 31-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/14/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following NON FINAL Office Action is in response to Applicant's submission received April 17, 2008. Applicant elected Group II (claims 15-26). Claims 31-48 have been added. Therefore, claims 15-26 and 31-48 are pending.

Election/Restrictions

2. Applicant's election without traverse of Group II (claims 15-26) in the reply filed on April 17, 2008 is acknowledged.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-26 and 31-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claims 15-26, the claims are directed towards a non-statutory system comprising only software. The claims fail to recite any physical structure. A statutory system is a physical object with physical structure, not software. Therefore, the claims recite non-statutory subject matter.

Regarding claims 31-40, the claims are directed towards a process. However, the method steps recited are not tied to another statutory class. Based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying

subject matter (such as an article or materials) to a different state or thing. See Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). Therefore, the claims fail to recite a statutory method.

Regarding claims 41-48, the claims are directed towards a computer program product embodied "in an information carrier." The broadest reasonable interpretation of "information carrier" includes non-statutory signals. Therefore, the claims recite non-statutory subject matter.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-21, 32-37, and 42-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 15, no physical structure is recited, making it unclear how the claim recites a "system."

As to claims 16, 32, and 42 it is unclear what the further validation achieves, since the entire task set is purportedly validated in claim 15. The claims appear redundant.

As to claim 17, 33, and 43 it is unclear what the difference between the "activate" in this claim and the "execute" in claim 15. It appears to be duplicative language.

As to claim 18 and 34 it is unclear what is meant by "progressively accept." Are there a series of tasks accepted one by one? Or is the acceptance done according to a "progressive" method?

As to claim 19, 35, it is unclear how the further validation achieves, since the tasks are already validated based on the constraints in claim 15.

As to claims 20-21, 36-37, and 44-45 it is unclear what the difference between "structural" and "containment" constraints is, because both achieve the same result in the claim - that it imposes which tasks are included in the instance template.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 15-26 and 31-48 rejected under 35 U.S.C. 102(b) as being barred by prior public disclosure in Shazia Sadiq, et al., "Pockets of Flexibility in Workflow Specification," Proceedings of the 20th International Conference on Conceptual Modeling, Lecture Notes In Computer Science 2224, pp. 513-526 (H.S. Kunii, et al., eds. 2001).

The Sadiq article, published more than a year before the effective filing date of the invention, is provided in the provisional application. All of the claimed elements are

supported in the Sadiq article. Therefore, the claimed invention was disclosed more than a year before the effective filing date.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Peter Mangan & Shazia Sadiq, "On Building Workflow Models for Flexible Processes," The Thirteenth Australasian Database Conference ADC2002 (28 January 2002).

Peter J. Mangan & Shazia Sadiq, "A Constraint Specification Approach to Building Flexible Workflows," J. Res. & Practice in IT, vol. 35, no. 1 (February 2003).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Saindon whose telephone number is (571)270-3026. The examiner can normally be reached on M-F 7:30-5; alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Van Doren can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3623

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/wvs/

/Jonathan G. Sterrett/

Primary Examiner, Art Unit 3623